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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,607	11/29/2000	Masayuki Homma	CANO:015	1179

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EXAMINER

KNAPP, JUSTIN R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 03/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,607

Applicant(s)

HOMMA, MASAYUKI

Examiner

Justin Knapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Examiner Notes

1. It is acknowledged the following papers have been received: Extension of Time as received 01/22/04.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. 1, 2, 8, 13, 14, 18, 23, 24, and 27 are rejected under 35 U.S.C. 112, 2nd paragraph.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, 13, 23, 24, and 27 recite the broad recitation "wherein said history information includes at least one of user identification information of a user who used said image forming device, an operating mode of said image forming device, and a number of sheets discharged from said image forming device", and the claim or claims dependent on those claims

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also recite “as a paper discharge counter table for each operating mode of said image forming device” which is the narrower statement of the range/limitation. The use of “at least one of” implies only one of the listed limitations is necessary.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6-9, 12-19, and 22- 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakasugi, JP409274547A.

6. Referring to system claim 1, device claim 7, apparatus claim 13, and method claims 17 and 23, Wakasugi teaches:

an image forming device (a printer) including a history information storage means (see Solution of Abstract, element 8) for storing history information relating to image processing executed a plurality of times by said image forming device, wherein said history information includes at least one of user identification information of a user who used said image forming device, an operating mode of said image forming device and a number of sheets discharged from said image forming device (see figure 3); and

an information processing apparatus (elements 1 and 2) including history information acquisition means for transmitting a history information acquisition request to said image

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forming device and for acquiring said history information stored by said history information storage (element 15) and storage means for storing said history information acquired by said history information acquisition means as a paper discharge counter table for each operating mode of said image forming device (it would be inherent that once the work stations (elements 1 and 2) received history information, it would be stored locally on the hard drive),

wherein said image forming device further includes transfer means for transferring said history information in accordance with said history information acquisition request to said image processing apparatus (element 15).

Wakasugi does not appear to explicitly teach a clearing means for clearing said history information relating to said image processing executed a plurality of times by said image forming device stored by said history information storing means when said history information is transferred to said information processing apparatus. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to also reset or clear the history information stored in the storing means of the printer taught by Wakasugi. One would have been motivated to do so because once the history information is transmitted and stored at a computer that requests the history information, clearing the history information would preserve memory space in the history storing means of the printer.

7. Referring to claims 2, 8, 14, 18, and 24, Wakasugi teaches wherein said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see figure 3).

8. Referring to claim 3, 9, 15, 19, and 25, Wakasugi teaches:

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a) acquisition receiving means for receiving said history information acquisition request transmitted from said information processing apparatus (element 23);

b) transmission means for transmitting said stored history information according to said history information acquisition job received from said acquisition receiving means (element 15).

9. Referring to claims 6, 12, 16, 22, and 26, Wakasugi teaches wherein said image forming device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Wakasugi has a printer as a image forming device that provides a printer function.

10. Claims 4, 5, 10, 11, 20, 21 and new claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakasugi, JP409274547A in view of Canon, JP10017202.

11. Referring to claim 4, 10, and 20, Wakasugi does not explicitly teach wherein said image forming device comprises notification means for notifying said information processing apparatus of an amount of said history information stored by said history information acquisition means. However, Canon teaches an error notification method for printers to inform an external apparatus based on history information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this within the system of Wakasugi the notification means teachings of Canon. One would have been motivated to do so because it would provide a quick notification command efficiently.

12. Referring to claim 5, 11, and 21, Wakasugi does not explicitly teach wherein said notification means notifies said information processing apparatus when said amount of history information reaches a predetermined amount. However, Canon teaches an error notification method for printers to inform an external apparatus based on history information (a

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predetermined set value of the paper remaining in the tray). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented this within the system of Wakasugi the notification means teachings of Canon based on when an amount of history information reaches a predetermined amount. One would have been motivated to do so because it would provide a quick notification command efficiently.

13. New claims 27-30 are rejected based on the teachings in claims 4, 5, 10, 11, 20, 21, and the teachings in the claims they are dependent on.

Response to Arguments

14. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (703) 308-6132. The examiner can normally be reached on Mon - Fri 9 am - 5:30 pm.

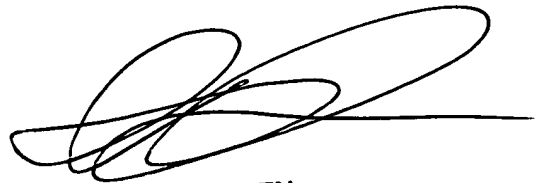
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Justin Knapp
Examiner
Art Unit 2182

March 21, 2004



**REHANA PERVEEN
PRIMARY EXAMINER**